



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,244	09/28/2005	Ken Umeno	215384-101174	4287
44200 7590 09/16/2008 HONIGMAN MILLER SCHWARTZ & COHN LLP 38500 WOODWARD AVENUE SUITE 100 BLOOMFIELD HILLS, MI 48304-5048				
EXAMINER				
AGHDAM, FRESHTEH N				
ART UNIT		PAPER NUMBER		
2611				
MAIL DATE		DELIVERY MODE		
09/16/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/551,244

Applicant(s)

UMENO, KEN

Examiner

FRESHTEH N. AGHDAM

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

Claim Objections

Claims 7, 16, 25, and 34 are objected to because of the following informalities:

As to claims 7, 16, 25, and 34, the parameter "u" is not defined in the recited claims. Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 37-38 are rejected under 35 USC 101 because the claimed invention is directed to non-statutory subject matter. Claims 37-38 claim a program that is a non-statutory subject matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As to claims 1-9 19-27, and 37, the claimed subject matter of "wherein the delay time[s] t_1 , ..., t_N is [are] shorter than a reciprocal number of a minimum value of clock rates of the multiple input received synchronized signals r_1 , ..., r_N " was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention because the specification lacks any description as to why this constraint is applied other than it is "assumed" (emphasis added) that the delay times are shorter than this value (par. 85), and moreover, it seems like by doing so some data is lost since the delay amount is less than the maximum of clock periods of the multiple input signals. According to the MPEP 2164.03 [r-2], the amount of guidance or direction needed to enable the invention is inversely related to the amount of knowledge in the state of the art as well as the predictability in the art. In re Fisher, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). The "amount of guidance or direction" refers to that information in the application, as originally filed, that teaches exactly how to make or use the invention. The more that is known in the prior art about the nature of the invention, how to make, and how to use the invention, and the more predictable the art is, the less information needs to be explicitly stated in the specification. In contrast, if little is known in the prior art about the nature of the invention and the art is unpredictable, the specification would need more detail as to how to make and use the invention in order to be enabling. >See, e.g., Chiron Corp. v. Genentech Inc., 363 F.3d 1247, 1254, 70 USPQ2d 1321, 1326 (Fed. Cir. 2004).

As to claims 10-18, 28-36, and 38, the claimed subject matter of "a delaying section that delays the respective multiple received signals a_1, \dots, a_L by time $T-t_1, \dots, T-t_N$ ($L \leq N$) where T is predetermined constant time without being overlapped with one another to output multiple intermediate signals" was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention because the limitation is unclear and the specification only adds one more sentence to the recited limitation which is " T may be any constant if it is larger than either delay time" see par. 112 (1) the examiner is unsure as to exactly what the applicant meant by this limitation and interpreted this limitation as T is predetermined constant time that causes the intermediate signals p_1, \dots, p_N not to overlap with one another. (2) There are no showings as how to determine the amount of T other than is any value greater than either delay time that seems to be inaccurate because not for any values greater than maximum of t_1, \dots, t_N it is possible to achieve nonoverlapping intermediate signals. The applicant is required to provide support(s) for the recited claimed subject matter. (3) As discussed above with respect to claims 1-9 19-27, and 37, the constraint defined for obtaining t_1, \dots, t_N in the specification is not enabling. According to the MPEP 2164.03 [r-2], the amount of guidance or direction needed to enable the invention is inversely related to the amount of knowledge in the state of the art as well as the predictability in the art. In re Fisher, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). The "amount of guidance or direction" refers to that information in the application, as originally filed, that teaches exactly how to make or use the invention. The more that is known in the

prior art about the nature of the invention, how to make, and how to use the invention, and the more predictable the art is, the less information needs to be explicitly stated in the specification. In contrast, if little is known in the prior art about the nature of the invention and the art is unpredictable, the specification would need more detail as to how to make and use the invention in order to be enabling. >See, e.g., Chiron Corp. v. Genentech Inc., 363 F.3d 1247, 1254, 70 USPQ2d 1321, 1326 (Fed. Cir. 2004).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10-18, 28-36, and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 10-18, 28-36, and 38, the claimed subject matter of "a delaying section that delays the respective multiple received signals a_1, \dots, a_L by time $T-t_1, \dots, T-t_N$ ($L \leq N$) where T is predetermined constant time without being overlapped with one another to output multiple intermediate signals" is indefinite.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Davidonvici et al (US 6,587,452) see figure 5; Shiu et al (US 6,624,767) see column 7, lines 20-29; Hwang (US 6,377,611) see column 1, lines 25-31; and Reed et al (US 2002/0136277) see figure 1.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRESHTEH N. AGHDAM whose telephone number is (571)272-6037. The examiner can normally be reached on 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chieh Fan can be reached on 571-272-3042. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Freshteh N Aghdam/

Examiner, Art Unit 2611

Application/Control Number: 10/551,244
Art Unit: 2611

Page 7

/Chieh M Fan/

Supervisory Patent Examiner, Art Unit 2611